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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,970	08/28/2001	Paul Trpkovski	44046.103.203.21	6340

22859 7590 06/27/2003

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EXAMINER

TRAN A, PHI DIEU N

ART UNIT	PAPER NUMBER
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3637

DATE MAILED: 06/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/940,970

Applicant(s)

TRPKOVSKI, PAUL

Examiner

Phi D A

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. et al (5866260) in view of Leavitt, Sr. et al (4940622).

Adams Jr. et al (figure 4B) shows a method of covering the window assembly by providing masking material comprising a substrate and an adhesive disposed over a first face of the substrate, forming a protective covering comprising the masking material on a surface of a pane, the protective covering being sized and positioned so that an unmasked apron of the surface extends between an outer periphery of the protective covering and an outer periphery of the pane, the unmasked apron (20b) being large to receive a sash (26, figure 5B) yet small enough that the protective covering protects a portion of the pane not covered by the sash.

Adams Jr. et al does not show the step providing information at the point of use of a window assembly comprising the step of pre-printing information on a second face of the substrate of the masking material before the step of forming the protective covering.

Leavitt Sr. et al shows the method of providing information at the point of use of a window assembly by pre-printing information on a second face of a substrate of the masking material (figure 2) to be mounted to a window to form a protective covering.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Adams Jr. et al to show the step providing information at the point of use of

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a window assembly comprising the step of pre-printing information on a second face of the substrate of the masking material before the step of forming the protective covering because it would enable the covering to have pre-finished instruction and labels as designed as taught by Leavitt Sr. et al.

3. Claims 4, 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. et al (5866260) in view of Smith (5330232).

Adams Jr. et al (figure 4B) shows a method of covering the window assembly having an insulating glass unit by providing masking material comprising a substrate and an adhesive disposed over a first face of the substrate, forming a protective covering comprising the masking material on a surface of a pane, the protective covering being sized and positioned so that an unmasked apron of the surface extends between an outer periphery of the protective covering and an outer periphery of the pane, the unmasked apron (20b) being large to receive a sash (26, figure 5B) yet small enough that the protective covering protects a portion of the pane not covered by the sash.

Adams Jr. et al does not show the step of providing information at the point of use of a window assembly comprising the step applying an information bearing sheet over the protective covering.

Smith (figure 6-7) shows the method step of applying an information bearing sheet over a substrate.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Adams Jr. et al to show the step of providing information at the point of use of a window assembly comprising the step applying an information bearing sheet over the

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protective covering as taught by Smith because it would enable the covering to illustrate designs, advertisement, instructions for users/workers/onlookers.

4. Claims 5, 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. et al (5866260) in view of Smith (5330232).

Adams Jr. et al as modified shows all the claimed limitations except for the information bearing sheet comprising a sheet stock and a second adhesive disposed upon a first face of the sheetstock, a second adhesive disposed upon a first face of the sheetstock, the sheetstock comprising a substantially frangible material, the sheetstock being paper.

Smith further shows the bearing sheet being a sheetstock and a second adhesive(43) disposed on a first face of the sheetstock (figure 7), the sheet stock being a substantially frangible material, the sheet stock being paper.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Adams Jr. et al's modified structure to show the information bearing sheet comprising a sheet stock and a second adhesive disposed upon a first face of the sheetstock, a second adhesive disposed upon a first face of the sheetstock, the sheetstock comprising a substantially frangible material, the sheetstock being paper as taught by Smith because it would enable the easy application of information on a substrate as taught by Smith.

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. et al (5866260) in view of Smith (5330232).

Adams Jr. et al as modified shows all the claimed limitations except for the second adhesive having substantially greater adhesion than the first adhesive.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Adams et al's modified structures to show the second adhesive having substantially greater adhesion than the first adhesive because it would enable easy peeling away of the information material from the covering without removing the covering from the pane surface.

6. Claims 9-12, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. et al (5866260) in view of Bigler (1284997).

Adams Jr. et al (figure 4B) shows a window assembly having an insulating glass unit (18, figure 4B) including a first pane having a first surface, a protective covering (22b, 24b) disposed over a masked portion of the first surface of the first pane, the protective covering being sized and positioned so that an unmasked apron of the surface extends between an outer periphery of the protective covering and an outer periphery of the pane, the unmasked apron (20b) being large to receive a sash (26, figure 5B) yet small enough that the protective covering protects a portion of the pane not covered by the sash.

Adams Jr. et al does not show the protective covering comprising a plurality of strips disposed across the first surface of the first pane, the strips being disposed in a sequentially overlapping fashion with each subsequent strip overlapping a portion of a preceding strip so that the protective covering can be easily removed on strip at a time.

Bigler shows a plurality of covering strips overlapping sequentially to provide covering to a large surface.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Adams et al to show the protective covering comprising a plurality of strips

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disposed across the first surface of the first pane, the strips being disposed in a sequentially overlapping fashion with each subsequent strip overlapping a portion of a preceding strip so that the protective covering can be easily removed on strip at a time because it was known in the art that covering a large surface with multiple covering strips of material instead of a large one would enable cost savings per manufacturing and transportation ease as taught by Bigler.

Per claims 11-12, 24, Adams et al as modified by Bigler shows the plurality of strips comprising a second strip partially overlapping a first strip, a third strip partially overlapping the second strip, the plurality of trips comprising n strips with the n th strip partially overlapping an $(n-1)$ strip of the plurality of protective strips, each strip of the protective covering having a tab portion (the part overlapping each other).

7. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. et al (5866260) in view of Bigler (1284997).

Adams et al as modified by Bigler shows all the claimed limitations except for the n th strip including indicia for indicating the n th strip to be first removed.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Adams et al to show the n th strip including indicia for indicating the n th strip to be first removed because having the n th strip including indicia for indicating the n th strip to be first removed would have been obvious as it was known in the art that removing the n th strip when there are multiple overlapping coverings would enable easy, safe, and clean peeling of the coverings from the pane assembly and the indicia would help ensure the proper procedure is followed.

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8. Claims 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. et al (5866260) in view of Bigler (1284997) as applied to claim 9 above and further in view of Smith (5330232)

Adams et al as modified by Bigler shows all the claimed limitations except for an information bearing sheet overlaying the protective covering, the information bearing sheet comprising a sheetstock having a first side and a second side, the information bearing sheet including second indicia printed on a second side thereof, the information bearing sheet including first indicia printed on a first side thereof, the information bearing sheet including a second adhesive overlaying the first indicia and the first side of the sheetstock.

Smith (figure 7) shows an information bearing sheet (44) overlaying the protective covering(24), the information bearing sheet comprising a sheetstock having a first side and a second side, the information bearing sheet including second indicia (25) printed on a second side thereof, the information bearing sheet including first indicia (46) printed on a first side thereof, the information bearing sheet including a second adhesive(43) overlaying the first indicia and the first side of the sheetstock

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Adams et al's modified structure to show an information bearing sheet overlaying the protective covering, the information bearing sheet comprising a sheetstock having a first side and a second side, the information bearing sheet including second indicia printed on a second side thereof, the information bearing sheet including first indicia printed on a first side thereof, the information bearing sheet including a second adhesive overlaying the first indicia and the first side of the sheetstock as taught by Smith because having the information bearing

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sheet having indicia on either first or second side with a second adhesive overlaying the indicia on the first side of the sheetstock would enable the easy application of the information bearing sheet to the substrate as taught by Smith.

9. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. et al (5866260) in view of Smith (5330232) and Bigler.

Adams Jr. et al as modified shows all the claimed limitations except for the second adhesive having substantially greater adhesion than the first adhesive.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Adams et al's modified structures to show the second adhesive having substantially greater adhesion than the first adhesive because it would enable easy peeling away of the information material from the covering without removing the covering from the pane surface.

10. Claims 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. et al (5866260) in view of Smith (5330232) and Bigler.

Adams Jr. et al as modified shows all the claimed limitations except for the second adhesive and the protective covering being substantially transparent or substantially translucent.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Adams et al's modified structures to show the second adhesive and the protective covering being substantially transparent or substantially translucent because having translucent/transparent covering and adhesive would enable the seeing through of the covered glass pane and thus allowing sun-light into a working environment which results in an appealing/lighted work area.

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11. Claims 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. et al (5866260) in view of Smith (5330232) and Bigler.

Adams et al as modified shows all the claimed limitations except for the indicia having an advertisement for goods likely to be purchased, the indicia having a National Fenestration Rating Council rating for the window assembly.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Smith to show the indicia having an advertisement for goods likely to be purchased, the indicia having a National Fenestration Rating Council rating for the window assembly because it would have been an obvious matter of design choice to show the indicia having an advertisement for goods likely to be purchased, or the indicia having a National Fenestration Rating Council rating for the window assembly as the establishment of different advertisements and instructions on a label is well-known in the art.

12. Claims 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. et al (5866260) in view of Bigler.

Adams et al as modified shows all the claimed limitations except for an adhesive disposed over a first face of the substrate, the tab portion of each strip overlapping a second portion of the substrate so that the adhesive overlaying the first portion is adhered to the adhesive overlaying the second portion.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Adams Jr. et al's modified structure to show an adhesive disposed over a first face of the substrate, the tab portion of each strip overlapping a second portion of the substrate so that the adhesive overlaying the first portion is adhered to the adhesive overlaying

the second portion because it would further enhance the attachment of one strip of the protective covering to another strip of the protective covering.

13. Claims 26-28, 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. et al (5866260) in view of Bigler.

Adams Jr. et al shows a method of protecting a masked area of a surface having the steps of providing masking material having a width, the protective covering having a plurality of strips, the covering having an unmasked apron on the first surface surrounding the protective covering.

Adams Jr. et al does not show the step of providing the width of the masking material to a masking calculator, providing a desired width of the masking area to the masking calculator, calculating a number of strips and an overlap dimension for forming the covering sized so that an unmasked apron of the first surface surrounds the covering, applying the plurality of strips to the surface in an overlapping fashion according to the overlap dimension, the step of detecting a dimension of the planar surface.

Bigler shows the steps of covering a large area with a protective covering by overlapping a plurality of covering in sequential fashion with each strip partially overlapping a preceding strip by the overlap dimension.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Adams Jr. et al to show the step of providing the width of the masking material to a masking calculator, providing a desired width of the masking area to the masking calculator, calculating a number of strips and an overlap dimension for forming the covering sized so that an unmasked apron of the first surface surrounds the covering, applying the

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plurality of strips to the surface in an overlapping fashion according to the overlap dimension as taught by Bigler, the step of detecting a dimension of the planar surface because having the protective covering made of a plurality of strips to cover a large area instead of a large one would enable cost savings per manufacturing and transportation ease, and the use of a calculator, a computer etc...to calculate an optimum result per a certain dimension of a covering is well-known in the art as it helps provide quick accurate calculations and thus cost savings.

Response to Arguments

14. Applicant's arguments with respect to claims 1-2,4-32 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art shows different window coverings.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phi D A whose telephone number is 703-306-9136. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Phi Dieu Tran A
June 23, 2003

PA

LANNA MAI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

